

REMARKS

Claims 1-86 are presently pending in this application. Claims 1, 10, 18, 22, 26, 29, 56, 62, 69, 72, 76, 78, 81, 83, and 84 are the independent claims.

In paragraph 1 of the Office Action, the Examiner advised that restriction must be made to one of the following inventions:

- I. Claims 1-9, drawn to a panel, classified in class 29, subclass 284.
- II. Claims 10-17, drawn to a wall or ceiling, classified in class 29, subclass 284.
- III. Claims 18-28, drawn to an enclosure, classified in class 29, subclass 284
- IV. Claims 29-71 and 81-82, drawn to 118, classified in class 118, subclass 326.
- V. Claims 72-75, 77, 79, drawn to a method of assembling an enclosure, classified in class 29, subclass 428.
- VI. Claims 76 and 80, drawn to a method of assembling a spray booth, classified in class 29, subclass 428.
- VII. Claim 78, drawn to a method of assembling a spray booth, classified in class 29, subclass 428.
- VIII. Claims 81-82, drawn to a self-supporting enclosure, classified in class 118, subclass 326.
- IX. Claim 83, drawn to a modular panel, classified in class 29, subclass 284.
- X. Claims 84-86, drawn to a corner post, classified in class 29, subclass 284.

In compliance with the established requirement, Applicant elects the claims grouped by the Examiner into Group IV, namely claims 29-71, 81, and 82. However, the restriction requirement, as it applies to Groups III (claims 22-28), IV, VI, VII, and VIII is respectfully traversed for the reasons set forth below. Applicant recognizes that restriction pertaining to Groups I, II, III (claims 18-21), IX and X is proper. However, the

inventions presented in claims 22-28 of Group III, and in the claims of Groups IV, VI, VII, and VIII, pertain to spray booths and/or have such identical or similar core apparatus features and/or have such core method features that restriction is not warranted and examination all-together is proper.

In the present application, it is respectfully submitted that the Examiner's search for prior art to elected Group IV will have to include the very same art that could well apply to non-elected Groups III (claims 22-28), VI, and VII and VIII. In addition, examination of those non-elected Groups along with Group IV will not be a serious burden on the Examiner.

Applicant submits that all of the spray booth claims should appropriately be contained within the same Group, i.e., Group IV. For example, Group IV includes claim 29, which provides for a spray booth comprising a plurality of panels having opposite ends selectively arrangable in series with opposing ends of adjacent panels being attached together to form a spray booth wall; at least one channel formed at one of the ends of at least one of the panels; and a post securable to an adjacent panel and rotationally engageable within the at least one channel to releasably engage the at least one panel to attach the ends of the adjacent panels.

Non-elected claims 22-28 of Group III also relate to spray booths (as opposed the other claims in Groups I, II and III which pertain to panels, walls/ceilings, and enclosures, respectively) and these non-elected claims provide for the same and/or similar features as shown in the spray booth claims of group IV. As will be apparent to those of ordinary skill in the art, much of the structures set forth in the non-elected claims 22-28 are the same and/or similar as the structure disclosed in claim 29.

While applicant does not concede that the different features set forth in the claims are obvious variations of one another, applicant does submit that a search for prior art to any one of these different configurations and methods would not be limited in a manner to exclude prior art which is in fact closer to one of the non-elected claims. Applicant believes that a reasonable search for prior art to, for example, the invention set forth in claim 29, would be of the scope which would also encompass prior art to the remaining claims, including claims 22-28, 76, 78, 80-82 (i.e., Group III (claims 22-28 only), and Groups VI, VII, and VIII). This is so because a reasonable Examiner in formulating a search would be aware that he or she might be unable to find prior art supporting rejection under 35 U.S.C. Section 102, and therefore would also wish to search for art justifying a rejection under 35 U.S.C Section 103. Such prior art, since it is not anticipatory under Section 102, might well be closer to a non-elected Group of claims.

In other words, Applicant believes that it is unfair for the Examiner to require restriction since the features of the invention of Group IV would not prevent the Examiner from later applying prior art which is closer to the non-elected claims than to the elected claims.

While there have clearly been shown to be differences between the individual Groups of claims designated by the Examiner, Applicant submits that those differences would not impose a serious burden if the Groups were all examined in the same application. That is, the claims in Groups III (claims 22-28 only), IV, VI, VII and VIII clearly share certain “core” features, and even though they have other features that

differentiate the different Groups, examination of all of those features together would not be a serious burden on the Examiner.

Further, there is such a substantial overlap in the searches for these groups of claims that to require the examination of the present application be restricted to only one of them would result in substantial duplication of effort on the part of the Patent and Trademark Office. Moreover, even if it is assumed that the claimed groups are distinct, a review of the specification will reveal that the respective subject matters are so closely related as to warrant consideration in a single application for review and searching.

Neither the Applicant nor the Patent Office should be put to additional efforts which would be required by the multiple filing and prosecution of two applications; nor should the public at large be required to study two separate patent documents in order to have available before it the complete subject matter of the present single application. In addition, it is submitted that if Applicant were to proceed with the filing of another application, it might be subjected to essentially the same search, perhaps by a different Examiner on a different occasion, with different results. This would lead to general confusion and burden on both the Patent Office and the public.

With reference to paragraph 2 of the Office Action, the Examiner advised that inventions (V-VII) and (I-IV & VIII-X) are distinct. Applicant respectfully traverses the requirement and asserts the following: The Examiner advised that the apparatus as claimed can be used as a puzzle assembling game or the enclosure can be used to house animals instead of a spray booth. However, the apparatus as claimed in the elected Group IV, particularly claim 29, pertains to a spray booth. Moreover, the methods as presented in Groups VI and VII (collectively claims 76, 80 and 78) also

pertain to assembling of spray booths. Those method claims also contain core features present in the apparatus of claim 29. Accordingly, the basis for restriction (at least with respect to Groups III, IV, VI, VII, and VIII) is misplaced, and withdrawal of the requirement is earnestly requested.

Regarding paragraph 3 of the Office Action, the Examiner advised that inventions III, IV and VIII are directed to distinct apparatus claims where patentability is based on different combination of features recited in the independent claims of each group. There is no support or reference made to the Rules as to the particular basis of this restriction. Moreover, the claims of Group VIII, however, namely claims 81 and 82, are also included in Group IV as presented by the Examiner. For this reason the restriction pertaining to Group VIII is inconsistent and misplaced. Even if inclusion of claims 81 and 82 within Group IV was a typographical error or oversight, those claims should indeed be part of Group IV. For instance, Claim 81 of Group VIII includes the same core features shown in Claim 29 of Group IV. Group VIII does not effectively function as a unit without requiring the features shown in the claims of Group IV.

Moreover, claims 22-28 of Group III are not directed to an enclosure but to spray booths. Applicant submits that at least those spray booth claims of Group III should therefore be included with the other spray booth claims, namely those of Group IV. The features of the claims are sufficiently alike to warrant such grouping. Accordingly, claims 22-28 of Group III (together with claims 81 and 82 of Group VIII), should appropriately be included with those of Group IV.

The Examiner advised in paragraph 4 of the Office Action that inventions V-VII

are directed to distinct methods where patentability is based on different combination of features recited in the independent claims. Applicant also traverses this restriction, at least with respect to Groups VI and VII. There is no support or reference made to the Rules as to the particular basis of this restriction. Further, the method invention as recited in the claims of Group VI (claims 76 and 80) are specifically directed to methods of assembling spray booths, as is claim 79 of Group VII. Moreover, as will readily be apparent to those of ordinary skill in the art, the features set forth in Group VI and Group VII are the same as the features set forth in claim 29. All of these claims pertain to spray booths, and each include the same or similar core features. Grouping of these claims together is appropriate, and examination of them together would not be a serious burden.

The Examiner advises under paragraph 5 that inventions (III, IV & VIII) and (I-II, IX & X) are related as combination and sub-combination. The Examiner advised that the combination as claimed does not require the particulars of the sub-combination as claimed for patentability, and that the subcombination has utility by itself or in other combinations. Applicant does not traverse this restriction.

Applicant recognizes that restriction pertaining to Groups I, II, III (claims 18-21), IX and X is proper. However, the inventions presented in claims 22-28 of Group III, and in the claims of Groups IV, VI, VII, and VIII, pertain to spray booths and/or have such core apparatus features and/or have such core method features that examination all-together is warranted.

CONCLUSION

Applicant respectfully submits that in view of the foregoing, the restriction requirement has been overcome or rendered moot. While Applicant elects Group IV as referenced above, examination of claims 22-28 of Group III, and the claims of Groups VI, VII, and VIII is respectfully requested. Allowance of the pending application and prompt passage to issue are respectfully requested.

Applicant's undersigned attorney may be reached by telephone at (715) 835-5232 or by facsimile at (715) 835-9890. All correspondence should be directed to the below listed address.

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on November 10, 2005.

Nicole A. Zimmer 11/10/05
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